

Notice of Allowability

Application No.

10/781,181

Examiner

Tekchand Saidha

Applicant(s)

FIDOCK, MARK D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 16 February 2006.
2. ☒ The allowed claim(s) is/are 1 and 13-17.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☒ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>2/16/2006</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Notice of Allowability

1. Applicant's election of Group III (claims 1 & 13-17, SEQ ID NO: 5) with traverse, filed February 16, 2006, is acknowledged. Citing MPEP §803, Applicants argue that the two criteria for a proper restriction requirement are: (1) the inventions must be independent or distinct as claimed, and (2) there must be a serious burden on the Examiner if restriction is required.

Here the Examiner has not shown that there would be a serious burden on the Examiner given our contention that the three amino acid sequences, SEQ ID NO: 1, 3 and 5, disclosed in Applicant's specification would not impose an undue burden on the Examiner to search. Applicants respectfully request the joiner of Group I and Group II to the provisionally elected Group III.

This is not found persuasive because the sequences of SEQ ID NO: 1, 3 or 5 (Phosphodiesterases) are structurally and in the level of activity, independent and/or distinct. Further, depending upon the restricted group additional sequences will have to be searched from all commercial and US Patent data bases. This additional searching would therefore involve undue burden to the Examiner. The requirement is still deemed proper and is therefore made FINAL. Further, in view of the following examiner's amendment and cancellation of claims to non-elected inventions, Applicants' traversal to the restriction requirement is now moot.

2. Claims 1-17 are present in this application.

3. Claims 1 & 13-17 are allowed subject to the following Examiner's amendment.

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure

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consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Nicholas Slepchuk on March 30, 2006.

Cancel claims 2-12 without prejudice.

Amend claims as follows:

Claim 1, line 4, after 'SEQ ID NO: 5' insert ', and wherein said sequence has phosphodiesterase activity'.

Claim 15, line 1, delete 'Claim' and insert 'claim'.

Claim 16, line 1, delete 'Claim' and insert 'claim'.

Claim 17, line 1, delete 'Claim' and insert 'claim'.

5. The following is an examiner's statement of reasons for allowance:

This Application provides a phosphodiesterase sequence of SEQ ID NO: 5, or a polypeptide having at least 95% identity to the sequence of SEQ ID NO: 5 and having phosphodiesterase activity.

The closest prior art reference of record [Bloom et al. PNAS, 99:14188-14192 (1996), IDS] teaches a PDE7 phosphodiesterase splice variant which is 59.2% identical to Applicants' SEQ ID NO: 5. The reference, however, taken alone or in combination with other prior art teachings does not provide motivation to one of ordinary skill in the art to make the invention obvious.

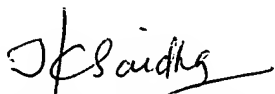
6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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March 30, 2006